

Kiener
(MM)54 039
US Patent Application 09/746,732

Remarks

Information Disclosure Statement

An Information Disclosure Statement is included with this Amendment. The Information Disclosure Statement includes appropriate certification and fees.

Claim Rejections Under 35 US 103

Claims 1-10 are rejected as being unpatentable over Neuhaus et al. (Neuhaus) in view of Ueda et al. (Ueda).

The prior art according to Neuhaus relates to the product of tamper proof documents by laminating an information carrier on one or both sides with foils, which have an adhesive layer that is hardened by radical cross-linking. This proposed production is made, for example, for a credit card or an identification card in a transparent foil in such a manner that the whole surface of the information carrier is not accessible without destruction of the carrier and, therefore, cannot be tampered with (column 1, lines 48-52). Therefore, this process for laminating an information carrier with plastic foil relates to a tamper proof document as the final product. With respect to this fact, it is important that the transparent foil is laminated to the information carrier in such a way that the information carrier will be destroyed if it is delaminated or loses the transparent foil from the information carrier.

The present invention, however, relates to a product for producing a laminate that is suitable for further processes for forgery-proof documents. This is achieved by the process according to claims 1 or 2. In a first step, supporting films are delaminated and, in a second step, suitable substrates are laminated to the polymer film with information. This lamination compound is not a final product, such as an identification card or credit

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card, as in Neuhaus. It is, instead, an interim product that is suitable for further processes for forgery-proof documents. Consequently, Neuhaus is not comparable with the steps of the present invention. The kind of final laminate compound and the kind for building the laminate are quite different.

The further cited patent to Ueda refers to a process for duplicating a hologram on a photosensitive material film. In a first step, the photosensitive material is laminated on an original plate 5. In a second step, the photosensitive material is delaminated from the original plate.

The present invention, however, refers to a process for producing a laminate that delaminates (not laminates) a support film from at least one polymer film in a first step and laminates (not delaminates) at least one substrate in a subsequent step.

Furthermore, it should be noted that after laminating the photosensitive material of the original plate according to Ueda, a laser light processes the photosensitive film for producing a hologram. After the recording of the hologram, the photosensitive material is delaminated from the original plate. A final product is produced. Therefore, Ueda is similar to Neuhaus and refers to a different step in a processing procedure than the present invention. (See Ueda, column 2, lines 54-58).

The present invention refers to a process for delaminating supporting films from at least one polymer film and, after delaminating the supporting films from at least one polymer film and delaminating the supporting films, laminating at least one substrate to provide an interim product that can be processed in different ways. Those laminates according to the present invention are obviously different from a process for duplicating holograms on a polymer film.

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Further, it should be noted that in Ueda (see column 9, lines 35-38), a base film 53 is peeled-off from the final product cut into a sheet, so that the duplicate hologram can be bonded to an article as a hologram seal. The present invention, however, refers to a laminate that in the manner of being processed according to the present invention will be totally used for a forgery-proof document as shown according to Fig. 1.

Valid rejection under 35 USC 103(a) requires evidence of a suggestion or motivation for one skilled in the art to combine prior art references to produce the claimed invention. US Court of Appeals for the Federal Circuit (*Ecolochem inc. v Southern California Edison Co., Fed. Cir.*, No. 99/1043, 9/7/00).

The best defense against hindsight-based obviousness analysis is the rigorous application of the requirement for showing a teaching or motivation to combine the prior art references, according to the court.

In In Re Sang-Su Lee (00-1158) confirms the above decision in considering judicial review of PTO decisions. The Court of Appeals for the Federal Circuit held:

"Tribunals of the PTO are governed by the Administrative Procedure Act, and their rulings receive the same judicial deference as do tribunals of other administrative agencies. Dickinson v. Zurko, 527 U.S. 150, 50, USPQ2d 1930 (1999). Thus on appeal we review a PTO Board's findings and conclusions in accordance with the following criteria:

5 USC § 706 (2) The reviewing court shall --

(2) hold unlawful and set aside agency actions, findings, and conclusions found to be--

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(A) arbitrary, capricious, an abuse of discretion, or otherwise not in accordance with law;

.....
(E) unsupported by substantial evidence in a case subject to sections 556 and 557 of this title or otherwise reviewed on the record of an agency hearing provided by statute;

"For judicial review to be meaningfully achieved within these strictures, the agency tribunal must present a full and reasoned explanation of its decision. The agency tribunal must set forth its findings and the grounds thereof, as supported by the agency record, and explain its application of the law to the found facts. The Court has often explained:

"The Administrative Procedure Act, which governs the proceedings of administrative agencies and related judicial review, establishes a scheme of "reasoned decision making." Not only must an agency's decreed result be within the scope of its lawful authority, but the process by which it reaches that result must be logical and rational.

Allentown Mack Sales and Services, Inc. v. National Labor Relations Bd., 552 US 359, 374 (1998) (citation omitted). This standard requires that the agency not only have reached a sound decision, but have articulated the reasons for that decision. The reviewing court is thus enabled to perform meaningful review within the strictures of the APA, for the court will have a basis on which to determine "whether the decision was based on the relevant factors and whether there has been a clear error of judgment."

Citizens to Preserve Overton Park v. Volpe, 401 US 402, 416 (1971). Judicial review of

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a Board decision denying an application for a patent is thus founded on the obligation of the agency to make the necessary findings and to provide an administrative record showing the evidence on which the findings are based, accompanied by the agency's reasoning in reaching its conclusions. See In re Zurko, 258 F3d 1379, 1386, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001) (review is on the administrative record); In re Gartside, 203 F.3d 1305, 1314, 53 USPQ2d 1769, 1774 (Fed. Cir. 2000) (Board decision "must be justified within the four corners of the record").

"As applied to the determination of patentability vel non when the issue is obviousness, "it is fundamental that rejections under 35 USC §103 must be based on evidence comprehended by the language of that section." (Emphasis added) In re Grasselli, 713 F.2d 731, 739, 218 USPQ 769, 775 (Fed. Cir. 1983). The essential factual evidence on the issue of obviousness is set forth in Graham v. John Deere Co., 383 US 1, 17-18, 148 USPQ 459, 467 (1966) and extensive ensuing precedent. The patent examination process centers on prior art and the analysis thereof. When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness. (Emphasis added) See, e.g., McGinley v. Franklin Sports, Inc., 262 F.3d 1339, 1351-52, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001) ("the central question is whether there is reason to combine [the] references," a question of fact drawings on the Graham factors).

"The factual inquiry whether to combine references must be thorough and searching." Id. It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with. See, e.g., Brown &

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Williamson Tobacco Corp. v. Phillip Morris, Inc., 229 F.3d 1120, 1124-25, 56 USPQ2d

1456, 1459 (Fed. Cir. 2000) (“a showing of a suggestion, teaching, or motivation to combine the prior art references is an ‘essential component of an obviousness holding’”) (Emphasis added) (quoting C.R. Bard, Inc., v. M3 Systems, Inc., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998)); In re Dembicza, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) (“Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.””) (Emphasis added) In re Dance, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998) (there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the Applicant); In re Fine, 837 F.2d 1071, 1075, 5 USPQ2d 1635, 1637 (Fed. Cir. 1998) (“teachings of references can be combined only if there is some suggestion or incentive to do so.”) (emphasis in original) (quoting ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984)).

“The need for specificity pervades this authority. See, e.g., In re Kotzab, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) (“particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed”); In re Rouffet, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998) (“even when the level of skill in the art is high, the Board must identify specifically the principal, known to one of ordinary skill, that suggests the claimed combination. In other words, the Board must explain the reasons one of ordinary skill in the art would have been motivated to

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select the references and to combine them to render the claimed invention obvious.") In

re Fritch, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992) (the examiner can satisfy the burden of showing obviousness of the combination "only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.") (Emphasis added).

Neither Neuhaus nor Ueda motivate or suggest to one skilled in the art to combine these references to produce Applicant's claimed invention.

A person of ordinary skill in the art at the time the present invention was made would not combine the two cited prior art documents. Neuhaus relates to a final product, such as credit cards. Ueda relates to duplicating holograms for use as hologram seals. Neuhaus describes only a final lamination of transparent foil to photosensitive film. Ueda describes laminating a photosensitive material to an original plate for recording a hologram that is followed by a step for delaminating the photosensitive material from the original plate. Furthermore, Ueda discloses that the hologram seal, if used for forgery-proof documents, will be produced by peeling-off a base film for trading a hologram seal.

Two different objects of the inventions are disclosed in Neuhaus and Ueda compared to the present invention, and the object of Neuhaus and Ueda do not show a process for producing a laminate according to the present invention, which starts with a film comprising at least one polymer film with supporting films arranged at least on both sides of the polymer film, removing the supporting film, and laminating substrates for a laminate compound.

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Given the above discussion of the differences between the present invention and Neuhaus and Ueda, claims 10 and 11 of the present invention are inventive, and should be allowable.

A one-month extension of time in which to respond to the outstanding Office Action is hereby requested. Credit Card Payment Form PTO-2038 is enclosed to cover the prescribed Large Entity one-month extension fee of \$55.00. Please charge any additional fees or credit any overpayments to Deposit Account 11-0665. A duplicate of this page is enclosed for this purpose.

Respectfully submitted,


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I hereby certify this correspondence is being submitted to the Commissioner for Patents, Washington, D.C. 20231 by facsimile transmission, fax number (703) 872-9310, on January 17, 2003.



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